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10/573,075	03/23/2006	Patrick Becker	28371US0PCT	6985
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
SNELTING, ERIN LYNN				
ART UNIT		PAPER NUMBER		
4151				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/573,075

Applicant(s)

BECKER ET AL.

Examiner

Erin Snelling

Art Unit

4151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-17 is/are rejected.
7) ☒ Claim(s) 7, 15, 16 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-854)
Paper No(s)/Mail Date 03-23-2006, 09-21-2007
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: the steps subsequent to step "a)" on page 4, line 5 are mislabeled as follows:

- a. page 16, line 3, "a)" should be **"b)"**
- b. page 16, line 27, "b)" should be **"c)"**
- c. page 17, line 20, "c)" should be **"d)"**
- d. page 18, line 26, "d)" should be **"e)"**
- e. page 21, line 4, "e)" should be **"f)"**

Appropriate correction is required.

Claim Objections

2. Claims 7, 15, and 16 are objected to because of the following informalities:

- a. Claim 7 reads "...wherein the substrate be coated...". It appears this phrase should read "...wherein the substrate **to** be coated...".
- b. Claim 15 contains element "the electrically conductive coating", which lacks antecedent basis in Claim 13. It appears that Claim 15 should be dependent on Claim **14**, wherein the proper antecedent basis would be "an electrically conductive coating" of Claim 14, line 2, and will be examined as such.
- c. Claim 16 is dependent on Claim 12, which is a dependent method claim of independent method Claim 1. It appears Claim 16 should be dependent on Claim 13, and will be examined as such.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 6, 7, 9, 10, 11, 13, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Takamizawa '626 (US Patent No. 5,096,626).

5. Regarding claim 1, Takamizawa '626 teaches:

- a. using doctoring, flow coating, or immersion to coat a substrate (column 4, lines 55-57) with a lacquer composition in which a silicon-based adhesion promoter ("at least one film-forming component such as a silane coupling agent", column 3, lines 31-32) and inorganic particles (column 3, lines 34-37) are present in a ratio of from 1:9 to 9:1 in a solvent (Example 1: column 7, line 61 – column 8, line 15 gives 100 parts silanes plus 300 parts antimony oxide to 150 plus 150 parts solvent, equalling a ratio of 400:300, or 1.33:1) which, where appropriate, may also comprise flow control agent (column 4, lines 46-49)
- b. drying the lacquer composition on the substrate, thus obtaining the coated substrate (column 4, lines 57-60)
- c. using one or more substrates thus coated to construct a polymerization cell, where the coated sides are the interior of the cell (column 2, lines 47-50)

- d. charging a polymerizable liquid composed of monomers capable of free-radical polymerization, where appropriate with polymeric content, to the polymerization cell (column 4, lines 49-50 and column 4, lines 61-65)
 - e. free-radical polymerization of the polymerizable liquid in the presence of a polymerization initiator, whereupon the internal inorganic coating transfers from the substrate into or onto the surfaces of the free-radical-polymerized plastic or of the plastics article (column 8, lines 24-31)
 - f. removing the coated plastics article with inorganic coating on one or more sides from the polymerization cell (column 5, lines 21-23).
6. Regarding claim 4, Takimizawa '626 teaches the adhesion promoter is composed of a colloidal solution of SiO₂ particles or of silane condensates (column 3, lines 31-32).
7. Regarding claim 6, Takimizawa '626 teaches the lacquer composition further comprises a surfactant or a mixture of surfactants as flow control agent (column 4, lines 46-49).
8. Regarding claim 7, Takimizawa '626 teaches the substrate to be coated is a glass sheet, a plastics sheet, or a plastics film ("forming an anti-reflecting film and/or a hard coat film on the working surfaces of a pair of plate molds...In the practice of the present invention, molds made of a glass or metal can be used", column 2, lines 47-48 and lines 52-53).

9. Regarding claim 9, Takimizawa '626 teaches the substrate is dried with the lacquer composition at a temperature in the range from 80 to 120°C (column 4, lines 57-59).
10. Regarding claim 10, Takimizawa '626 teaches the polymerizable liquid is polymerized at from 40 to 80°C (column 8, lines 62-67).
11. Regarding claim 11, Takimizawa '626 teaches use is made of a polymerization cell in essence consisting of two sheets with peripheral sealing bead (column 2, lines 47-51).
12. Regarding claim 13, Takimizawa '626 teaches a plastics article obtained by a process according to claim 1 ("a plastic lens", column 2, line 44).
13. Regarding claim 17, Takimizawa '626 teaches a plastics article for encasing structures, for equipping cleanrooms, for machine covers, for incubators, for displays, for visual display screens and visual-display- screen covers, for rear-projection screens, for medical apparatus, or for electrical devices comprising the plastics article of Claim 13 (column 1, lines 11-12).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

16. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamizawa '626 (US Patent No. 5,096,626) in view of Lange '269 (EP Application Publication 0 193 269).

17. Regarding claim 2, Takamizawa '626 does not teach the plastics article has the shape of a flat sheet. In analogous art of coatings, Lange '269 teaches the plastics article has the shape of a flat sheet (page 5, lines 27-30) for the benefit of providing versatile applications for the final product. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the process of Takamizawa '626 with the flat sheet of Lange '269 for the benefit of providing versatile applications for the final product.

18. Regarding claim 3, Takamizawa '626 does not teach the plastics article obtainable via free-radical polymerization is a polymethyl methacrylate or a polystyrene. In analogous art of coatings, Lange '269 teaches teach the plastics article obtainable via free-radical polymerization is a polymethyl methacrylate or a polystyrene (page 6, lines 6-8) for the benefit of simplifying manufacturing by using a readily available and easily formable material. It would have been obvious to one of ordinary skill in the art at the

time of the invention to combine the process of Takamizawa '626 with the polymethyl methacrylate or polystyrene of Lange '269 for the benefit of simplifying manufacturing by using a readily available and easily formable material.

19. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takamizawa '626 (US Patent No. 5,096,626) in view of Kaneshiro '695 (US Patent No. 7,416,695) or Kaneshiro '882 (WO 02/102882 A1).

20. Regarding claim 5, Takamizawa '626 teaches the lacquer composition comprises from 1 to 2% by weight of SiO₂ particles ("colloidal silica", column 3, line 34, and "a solution of solid content of 1~40% by weight in said solvent is preferably used", column 4, lines 41-43) in water as solvent ("Useful solvents include...water", column 4, lines 35-41). Takamizawa '626 also teaches antimony oxide particles (column 3, lines 36-37), but Takamizawa '626 does not teach from 2.5 to 7.5% by weight of antimony tin oxide. In analogous art of conductive coatings, Kaneshiro '695 (or Kaneshiro '882) teaches from 2.5 to 7.5% by weight of antimony tin oxide (column 10, lines 55-61 and column 12, lines 43-46) for the benefit of using a conductor compatible its polymer carrier, and in an amount that provides enhanced conductivity without sacrificing mechanical strength. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the process of Takamizawa '626 with the antimony tin oxide of Kaneshiro '695 (or Kaneshiro '882) for the benefit of using a conductor compatible its polymer carrier, and in an amount that provides enhanced conductivity without sacrificing mechanical strength.

21. Claims 8, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takamizawa '626 (US Patent No. 5,096,626) in view of Kawaguchi '361 (US Patent No. 4,571,361).

22. Regarding claim 8, Takamizawa '626 does not teach the plastics sheet or plastics film is composed of polyethylene terephthalate. In analogous art of coatings, Kawaguchi '361 teaches teach the plastics sheet or plastics film is composed of polyethylene terephthalate (column 8, lines 12-14) for the benefit of obtaining the desired transparency and adhesion with the coating. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the process of Takamizawa '626 with the polyethylene terephthalate of Kawaguchi '361 for the benefit of obtaining the desired transparency and adhesion with the coating.

23. Regarding claim 14, Takamizawa '626 does not teach the article has an electrically conductive coating with a surface resistance smaller than or equal to $10^{10}\Omega$. In analogous art of coatings, Kawaguchi '361 teaches the article has an electrically conductive coating (column 4, lines 66-68) with a surface resistance smaller than or equal to $10^{10}\Omega$ (column 8, lines 19-20) for the benefit of enhancing anti-static properties of the coated substrate. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the process of Takamizawa '626 with the electrically conductive coating of Kawaguchi '361 for the benefit of enhancing anti-static properties of the coated substrate.

24. Regarding claim 15, Takamizawa '626 does not teach the layer thickness of the electrically conductive coating is in the range from 200 to 5000 nm. In analogous art of

coatings, Kawaguchi '361 teaches the layer thickness of the electrically conductive coating is in the range from 200 to 5000 nm (column 8, lines 12-15) for the benefit of achieving adequate conductivity as well as mechanical strength. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the process of Takamizawa '626 with the coating thickness of Kawaguchi '361 for the benefit of achieving adequate conductivity as well as mechanical strength.

25. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takamizawa '626 (US Patent No. 5,096,626) in view of Schlarb '436 (US Patent No. 6,794,436).

26. Regarding claim 16, Takamizawa '626 does not teach scrub resistance of the inorganically coated surface to DIN 53 778 is at least 10 000 cycles. In analogous art of coatings, Schlarb '436 teaches scrub resistance of the inorganically coated surface to DIN 53 778 is at least 10 000 cycles (column 13, lines 64-66 and column 15, Table II) for the benefit of ensuring continued adherence of the coating to the substrate for an extended lifetime of use of the final product. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the process of Takamizawa '626 with the scrub resistance of Schlarb '436 for the benefit of ensuring continued adherence of the coating to the substrate for an extended lifetime of use of the final product.

Double Patenting

26. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

27. Claims 1-13, 15, and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12, 14, 16, and 17 of copending Application No. 11/572716. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are fully encompassed by the claims of the copending application, as shown in Table 1 below.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Table 1

Instant Application	Application No. 11/572716
1. A process for producing a plastics article from a plastic obtainable via free-radical polymerization with inorganic coating on one or more sides via the following process steps :	1. Process for producing a plastics article from a plastic obtainable via free-radical polymerization with inorganic coating on one or more sides via the following process steps:

<p>a) using doctoring, flow coating, or immersion to coat a substrate with a lacquer composition in which a silicon-based adhesion promoter and inorganic particles are present in a ratio of from 1:9 to 9:1 in a solvent which, where appropriate, may also comprise flow control agent</p> <p>b) drying the lacquer composition on the substrate, thus obtaining the coated substrate</p> <p>c) using one or more substrates thus coated to construct a polymerization cell, here the coated sides are in the interior of the cell</p> <p>d) charging a polymerizable liquid composed of monomers capable of free-radical polymerization, where appropriate with polymeric content, to the polymerization cell</p> <p>e) free-radical polymerization of the polymerizable liquid in the presence of a polymerization initiator, whereupon the internal inorganic coating transfers from the substrate into or onto the surfaces of the free-radical-polymerized plastic or of the plastics article</p> <p>f) removing the coated plastics article with inorganic coating on one or more sides from the polymerization cell</p>	<p>a) using doctoring, flow coating, or immersion to coat a substrate with a lacquer composition in which a silicon-based adhesion promoter and inorganic particles are present in a ratio of from 1:9 to 9:1 in a solvent which, where appropriate, may also comprise flow control agent,</p> <p>b) drying the lacquer composition on the substrate, thus obtaining the coated substrate,</p> <p>c) using one or more substrates thus coated to construct a polymerization cell, where the coated sides are in the interior of the cell,</p> <p>d) charging a polymerizable liquid composed of monomers capable of free-radical polymerization, where appropriate with polymeric content, to the polymerization cell, where the polymerizable liquid comprises from 0.16 to 0.28% by weight of a release agent mixture composed of a C6-C20-alkyl sulphosuccinate and of a C6-C20-alkyl phosphate.</p> <p>e) free-radical polymerization of the polymerizable liquid in the presence of a polymerization initiator, whereupon the internal inorganic coating transfers from the substrate into or onto the surfaces of the free-radical-polymerized plastic or of the plastics article</p> <p>f) removing the coated plastics article with inorganic coating on one or more sides from the polymerization cell</p>
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<p>2. The process according to Claim 1, wherein the plastics article has the shape of a flat sheet.</p> <p>3. The process according to Claim 1, wherein the plastic obtainable via free-radical polymerization is a polymethyl methacrylate or a polystyrene.</p> <p>4. The process according to Claim 1, wherein the adhesion promoter is composed of a colloidal solution of SiO₂ particles or of silane condensates.</p> <p>5. The process according to Claim 1, wherein the lacquer composition comprises from 1 to 2% by weight of SiO₂ particles and from 2.5 to 7.5% by weight of antimony tin oxide particles in water as solvent.</p> <p>6. The process according to Claim 5, wherein the lacquer composition further comprises a surfactant or a mixture of surfactants as flow control agent.</p> <p>7. The process according to Claim 1, wherein the substrate to be coated is a glass sheet, a plastics sheet, or a plastics film.</p> <p>8. The process according to Claim 7, wherein the plastics sheet or a plastics film is composed of polyethylene terephthalate.</p> <p>9. The process according to Claim 1, wherein the substrate is dried with the lacquer composition at a temperature in the range from 80 to 120°C.</p>	<p>2. Process according to Claim 1, wherein the plastics article has the shape of a flat sheet.</p> <p>3. The process according to Claim 1, wherein the plastic obtainable via free-radical polymerization is a polymethyl methacrylate or a polystyrene.</p> <p>4. The process according to Claim 1, wherein the adhesion promoter is composed of a colloidal solution of SiO₂ particles or of silane condensates.</p> <p>5. The process according to Claim 1, wherein the lacquer composition comprises from 1 to 2% by weight of SiO₂ particles and from 2.5 to 7.5% by weight of antimony tin oxide particles in water as solvent.</p> <p>6. The process according to Claim 5, wherein the lacquer composition also comprises a surfactant or a mixture of surfactants as flow control agent.</p> <p>7. The process according to Claim 1, wherein the substrate to be coated is a glass sheet, a plastics sheet, or a plastics film.</p> <p>8. The process according to Claim 7, wherein the plastics sheet or a plastics film is composed of polyethylene terephthalate.</p> <p>9. The process according to Claim 1, wherein the substrate is dried with the lacquer composition at a temperature in the range from 80 to 120°C.</p>
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<p>10. The process according to Claim 1, wherein the polymerizable liquid is polymerized at from 40 to 80°C.</p> <p>11. The process according to Claim 1, wherein use is made of a polymerization cell in essence consisting of two sheets with peripheral sealing bead.</p> <p>12. The process according to Claim 1, wherein a sheet of polymethyl methacrylate plastic is produced with an electrically conductive coating on one or two sides.</p> <p>13. A plastics article obtained by a process according to Claim 1.</p> <p>15. The plastics article according to Claim 13, wherein the layer thickness of the electrically conductive coating is in the range from 200 to 5000 nm.</p> <p>16. The plastics article according to Claim 12 (--13--), wherein a scrub resistance of the inorganically coated surface to DIN 53 778 is at least 10 000 cycles.</p>	<p>10. The process according to Claim 1, wherein the polymerizable liquid is polymerized at from 40 to 80°C.</p> <p>11. The process according to Claim 1, wherein use is made of a polymerization cell in essence consisting of two sheets with peripheral sealing bead.</p> <p>12. The process according to Claim 1, wherein a sheet of polymethyl methacrylate plastic is produced with an electrically conductive coating on one or two sides.</p> <p>14. A plastics article obtained by a process according to Claim 1.</p> <p>16. The plastics article according to Claim 14, wherein the layer thickness of the electrically conductive coating is in the range from 200 to 5000 nm.</p> <p>17. The plastics article according to Claim 14, wherein a scrub resistance of the inorganically coated surface to DIN 53 778 is at least 10 000 cycles.</p>
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erin Snelting whose telephone number is (571)272-7169. The examiner can normally be reached on Monday to Thursday 8:00 to 6:00 and every other Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Ortiz can be reached on (571)272-1206. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert B Davis/
Primary Examiner, Art Unit 1791
For Angela Ortiz, SPE 4151
11/6/08

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